

Application Serial No. 10/630,968
Amendment Dated 24 November 2006
Reply to Office Action mailed 24 May 2006

AMENDMENTS TO THE DRAWINGS

The attached five sheets of drawing include changes to Figures 4-8. These five sheets containing Figures 4-8 replace the original five sheets including Figures 4-8. The Figures have been corrected as suggested by the Examiner at page 2 of the Office Action to utilize distinguishable shapes of symbols for the data set forth in these figures.

Attachment: Replacement Sheets

REMARKS

Claim 17 has been amended to specify transfecting cells "*in vitro*." Support for this language can be found throughout the specification.

Claim 18 has been amended to provide the proper antecedent basis.

Claims 24-29 have been canceled as being directed to a non-elected invention without prejudice to filing in one or more divisional applications.

The Figures have been corrected as suggested by the Examiner at page 2 of the Office Action to utilize distinguishable shapes of symbols for the data set forth in these figures.

Applicants submit that none of these amendments constitute new matter, and their entry is requested.

The Examiner objected to the drawings. Applicants have provided corrected drawings in response to this objection. Applicants submit that these corrected drawings obviates this objection, and its withdrawal is requested.

The Examiner rejected claim 18 under 35 U.S.C. § 112, second paragraph for being indefinite. Applicants submit that the amendment to claim 18 obviates this rejection, and its withdrawal is requested.

The Examiner rejected claims 17-23 under 35 U.S.C. § 112, first paragraph for lack of enablement for the full scope of the claimed invention. Although Applicants do not agree with the Examiner in this rejection, they have nevertheless amended the claims to be directed to an *in vitro* use in order to expedite the prosecution of the present application without prejudice to pursuing an *in vivo* use in a continuation application.

In view of the above amendments and remarks, Applicants submit that the subject matter of claims 17-23 is fully enabled by the specification. Withdrawal of this rejection is requested.

The Examiner rejected claims 22-23 under 35 U.S.C. § 102 (a) as being anticipated by Castanotto et al. (*RNA* 8:1454-1460, 2002). Castanotto et al. was published after both of the U.S. provisional patent applications to which priority under 35 U.S.C. § 119(e) has been claimed. Applicants note that Example 7 of U.S. Serial No. 60/408,298 filed on 6 September 2002 prior to

the publication date of Castanotto et al. discloses the invention of claims 22 and 23. Specifically, paragraph [0041] on page 10 of the '298 application discloses "[B]y utilizing the PCR strategy, several siRNA genes can be simultaneously tested in a single transfection experiment." In addition, paragraph [0042] on page 10 of the '298 application discloses "[A] mix of several siRNAs can be simultaneously co-transfected with the inducible target-EGFP cassette into the cell line containing the trans-activator. Also, Example 7 of the '298 application discloses transfecting a cell with two siRNA PCR products. Finally, the Examiner's attention is directed to paragraph [0043] on page 11 of the '298 application. In view of these disclosures in the '298 application, Applicants submit that the subject matter of claims 22 and 23 of the present application is entitled to the priority date of 6 September 2006 which antedates Castanotto et al.

In view of the above remarks, Applicants submit that Castanotto et al. does not anticipate the claimed subject matter. Withdrawal of this rejection is requested.

The Examiner rejected claims 1-5 and 8-21 under 35 U.S.C. §103(a) as being unpatentable over Paddison (published in 2002), Tuschl (published in 2002), Yu (published in 2002), Livache (1998), and Jones (1990). The application claims the priority of 60/399,718, filed 8/1/2002 and 60/408,298, filed 9/6/2002. The applicants respectfully suggest that a *prima facie* case of obviousness has not been made because, in view of the claimed priority, none of Paddison, Tuschl, or Yu are prior art to the present invention. In view thereof, the applicants respectfully request the withdrawal of the instant rejection.

The Examiner rejected claims 6-7 under 35 U.S.C. §103(a) as being unpatentable over Tuschl (2002) and Livache (1998) in view of Jeng (1990). The applicants respectfully suggest that a *prima facie* case of obviousness has not been made because, in view of the claimed priority, Tuschl, is not prior art to the present invention. In view thereof, the applicants respectfully request the withdrawal of the instant rejection.

The Examiner rejected claims 22-23 under 35 U.S.C. §103(a) as being unpatentable over Gou (2003) in view of Paul (2002). The applicants respectfully suggest that a *prima facie* case of obviousness has not been made because, in view of the claimed priority, neither Gou nor Paul


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is prior art to the present invention. In view thereof, the applicants respectfully request the withdrawal of the instant rejection.

In view of the foregoing, it is submitted that all outstanding rejections are overcome and the present Application is now in condition for allowance. Withdrawal of the rejections and allowance are requested. The Director is authorized to charge any fees or overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

By


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